

REMARKS

Claims 1-2, 5, 9, 11-28 and 29-30 are pending. However, claims 1-2, 5, 9, and 11-28 are directed to a separate invention and are deemed withdrawn. Accordingly, only claims 29 and 30 are being examined.

Oath or Declaration:

In the Office Action, the Patent Office alleges the Declaration is defective because inventor Ledbetter has not signed. The Patent Office requires Applicants to submit a new oath or declaration in compliance with 37 C.F.R. §1.67(a).

Applicants respectfully disagree.

Applicants previously filed a Declaration under 37.C.F.R.§1.63 which was executed by fewer than all named inventors together with an accompanying Petition under 37 C.F.R. §1.47(a) to accept the Declarations of named inventors Jurgen Bajorath, Robert Peach, Philip Wallace, Nitin Damle, Peter Linsley, and William Brady on behalf of themselves and nonsigning inventor Jeffrey Ledbetter. The §1.47(a) Petition was granted by the U.S. Patent and Trademark Office. In support, Applicants submit herewith copies of the Decision Granting Status Under 37 C.F.R.§1.47(a) and a letter from the U. S. Patent Office addressed to inventor Ledbetter, both dated January 25, 2002 (attached herewith as **EXHIBIT 1**).

In the Specification:

In the Office Action, the Patent Office objects to the specification under 37 C.F.R. §1.809 for omitting the address of the depository American Type Culture Collection (ATCC).

In response, Applicants maintain that during the pendency of the subject application, access to the ATCC deposits, ATCC accession nos. 68629 and 10762, will be afforded to one determined by the Patent Commissioner to be entitled thereto under 35 U.S.C. §1.14 and §122, and all restrictions on the availability to the public of the DNA and/or the cell line deposited under the ATCC Accession numbers listed above will be irrevocably removed upon the issuance of a patent from the subject application. Furthermore, the above deposits will be maintained by the ATCC for a period of 30 years from the date of deposit or at least 5 years after the last request for a sample of the deposited material, whichever is longer. Where the ATCC cannot furnish samples of the above deposits for any reason, applicants shall make a replacement deposit, of the material which was originally deposited, within three months of receiving notification that the ATCC cannot furnish samples.

Double Patenting Rejection:

In the Office Action, the Patent Office rejects claims 29 and 30 under the judicially created doctrine of double patenting as allegedly unpatentable over: claims 3-4 of U.S. Patent No. 5,885,796; claims 1-6 of U.S. Patent No. 5,851,795; and claims 1-2 of U.S. Patent No. 5,844,095.

In response, Applicants will submit a Terminal Disclaimer upon indication of allowable subject matter.

Conclusion

Entry of this amendment and the foregoing remarks are respectfully requested. Applicant believes that all grounds for rejection of the claims have been overcome and that claims 29 and 30 are now in condition for allowance. Withdrawal of the Patent Office's rejections is requested and prompt allowance of the claims is solicited. If any issues remain in

Applicants: Peter S. Linsley, et al.
U.S. Serial No. 09/609,915
Filed: July 3, 2000
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connection with the claim, the Examiner is encouraged to contact the undersigned by telephone to discuss the same.

No fee is deemed necessary in connection with the filing of this Amendment. If any fee is necessary, the Patent Office is authorized to charge any additional fee to Deposit Account No. 50-0306.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Sarah B. Adriano", is written over a horizontal line.

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In response, Applicants amend the specification to include the current address of ATCC. However, Applicants have amended the specification at page 11, the first reference to the ATCC in the originally filed specification, rather than at suggested page 34.

Additionally, the Patent Office objects to the specification because the Summary of the Invention contains a disclosure outside the bounds of the claims being examined.

In response, upon indication of allowability, applicants will modify the brief summary of the invention and restrict the descriptive matter so as to be in harmony with the soon to be allowed claims (MPEP §1302.01).

Drawings:

In the Office Action, the Patent Office requires Applicants to submit new drawings in compliance with 37 C.F.R. §1.121(d). The Patent Office also requests that the new drawings be accompanied by a cover sheet marked "Drawings, Please place in Artifact folder."

In response, Applicants provide herein formal drawings accompanied by a cover sheet with the suggested markings (**EXHIBIT 2**).

Rejection Under 35 U.S.C. §112, First Paragraph:

In the Office Action, the Patent Office rejects claims 29 and 30 under 35 U.S.C. §112, first paragraph. The Patent Office is requiring Applicants to state that all restrictions on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent.



U.S. Serial No.
09/609,915

M&A Ref. 30436.30USI2

EXHIBIT 1

Decision Granting Status Under 37
C.F.R. §1.47(a) and letter from the
U.S. Patent Office addressed to
inventor Jeffrey A. Ledbetter



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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Paper No. 8

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JAN 25 2002

OFFICE OF PETITIONS

In re Application of
Peter S. Linsley et al
Application No. 09/609,915
Filed: July 3, 2000
For: SOLUBLE CTLA4 MUTANT
MOLECULES AND USES THEREOF

:
:
: DECISION GRANTING
: STATUS UNDER 37 CFR 1.47(a)

This is a decision on the petition filed January 4, 2002, requesting reconsideration of a decision mailed September 5, 2001, which refused to accord 37 CFR 1.47(a) status to the above-identified application.

The petition is granted.

Petitioner has shown that the non-signing inventor has refused to join in the filing of the above-identified application.

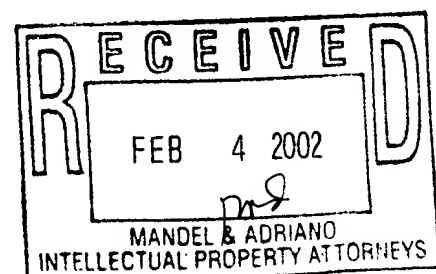
The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status. As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

Telephone inquiries regarding this decision should be directed to Petitions Examiner Wan Laymon at (703) 306-5685.

This application is being forwarded to Technology Center AU 1646 for examination in due course.


Frances Hicks

Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy



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Paper No. 9

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JAN 25 2002

OFFICE OF PETITIONS

In re Application of
Linsley; Ledbetter; Bajorath; peach; Brady; Wallace; and Damle
Application No. 09/609,915
Filed: July 3, 2000
For: SOLUBLE CTLA4 MUTANT MOLECULES AND USES THEREOF

Dear Mr. Ledbetter:

You are named as a joint inventor in the above identified United States patent application, filed under the provisions of 35 U.S.C. 116 (United States Code), and 37 CFR 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Telephone inquiries regarding this communication should be directed to Wan Laymon at (703) 306-5685. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1 (800) 972-6382 (outside the Washington D.C. area).

Frances Hicks

Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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